

REMARKS UNDER 37 CFR § 1.116

Formal Matters

Claims 1, 50-52, 56 and 68-85 are pending after entry of the amendment set forth herein.

Claims 1, 50-52, 56 and 68-85 were examined. Claims 1, 50-52, 56 and 68-85 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

Claims Rejected On Ground of Nonstatutory Obviousness-Type Double Patenting (US Pat. No. 6,506,149)

In the Office Action dated December 13, 2006, claims 1, 68-72 and 81-85 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 19-20, 31 and 34 of U.S. Patent No. 6,506,149. Although the claims are not identical, the Examiner considered them to be not patentably distinct because the Examiner interpreted both sets to be directed to an organ manipulation apparatus having at least one suction member having a vacuum space; a support structure and a joint coupled between the suction member and the support structure such that the suction member has freedom to move relative to the support structure in response to normal movement of the organ.

Although Applicants do not necessarily agree with this ground of rejection and do not acquiesce thereto (e.g., instant claim 1 recites that the suction member has freedom to move at least along an axis of the suction member relative to the support member, while claim 1 of the patent recites that the suction member has freedom to rotate), in order to advance the prosecution of the instant application, Applicants are submitting a terminal disclaimer concurrently herewith, to overcome this ground of rejection.

In view of the submission of the terminal disclaimer, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 68-72 and 81-85 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 19-20, 31 and 34 of U.S. Patent No. 6,506,149, as being moot.

Claims Rejected On Ground of Nonstatutory Obviousness-Type Double Patenting (US Pat. No. 6,899,670)

Claims 50-52 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,899,670. Although the claims are not identical, the Examiner considered them to be not patentably distinct because the Examiner interpreted both sets to be directed to a method of compliant retraction of an organ, and although claim 50 now recites a beating heart, the Examiner this to include the broader language claimed of an organ. The Examiner further noted that claims 2 of the '670 patent recites that the organ is a beating heart.

Although Applicants do not necessarily agree with this ground of rejection and do not acquiesce thereto, in order to advance the prosecution of the instant application, Applicants are submitting a terminal disclaimer concurrently herewith, to overcome this ground of rejection.

In view of the submission of the terminal disclaimer, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 50-52 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,899,670, as being moot.

Claim Rejected On Ground of Nonstatutory Obviousness-Type Double Patenting (US Pat. No. 6,730,020)

Claims 56 and 73-80 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 15-18 and 32 of U.S. Patent No. 6,730,020. Although the claims were not identical, the Examiner asserted that claim 56 was not patentably distinct as it was generic to claims 1 and 32 of the patent applied thereto.

Although Applicants do not necessarily agree with this ground of rejection and do not acquiesce thereto, in order to advance the prosecution of the instant application, Applicants are submitting a terminal disclaimer concurrently herewith, to overcome this ground of rejection.

In view of the submission of the terminal disclaimer, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 56 and 73-80 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 15-18 and 32 of U.S. Patent No. 6,730,020, as being moot.

Terminal Disclaimer Not Accepted

The Examiner indicated that the terminal disclaimer filed on 09/26/06 was not accepted since the person who signed the terminal disclaimer was not recognized as being authorized to act on behalf of the assignee, noting further that an attorney or agent, not of record, is not authorized to sign a terminal disclaimer. Applicants respectfully traverse this position. Applicants note that the person who signed the terminal disclaimer is an attorney of record, and that this is confirmed by an entry on the Public Pair database for this case. Nevertheless, in an effort to advance the prosecution of the instant application, Applicants are filing a Power of Attorney and Statement under 3.73(b) herewith to ensure that the Examiner enters the terminal disclaimers submitted herewith.

Conclusion

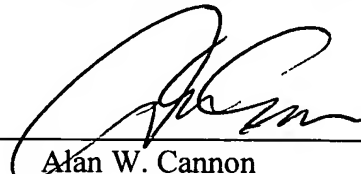
Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-028CON2.

Respectfully submitted,

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